

REMARKS

Reconsideration in view of the above amendments and following remarks is respectfully requested. Claim 11 has been cancelled. Claim 19 has been amended to make it an independent claim while claim 20 has been amended to make it dependent on Claim 19 rather than Claim 11. Claims 9 and 19 have previously been allowed. Claims 9, 19 and 20 are currently under consideration in the subject application.

A. Preliminary Remarks

As a preliminary matter, the Office Action, at page 2, suggests that Applicants have not properly claimed priority to earlier filed patent applications. On the contrary, in an "Application and Fee Transmittal" filed August 3, 2001, Applicants specifically requested that the specification be amended by adding the following language to the first line of the specification: "The present application is a divisional application of co-pending U.S. patent application Serial No. 09/527,345, filed March 17, 2000, which is related to Provisional Application 60/124,820, filed March 17, 1999. Under 35 U.S.C. 119 (e)(1), this application claims benefit of said Provisional Application."

At the time the present application was filed, this was an acceptable way to claim priority under the rules and regulations then in effect. Therefore, the present application does "contain a specific reference to the prior application(s) in the first sentence of the specification."

B. Rejections Addressed from February 11, 2004 Office Action (OA)

(1) Rejection of Claims 11 and 20 under 35 U.S.C. § 112, first paragraph

Claims 11 and 20 have been rejected under 35 U.S.C. § 112, first paragraph on the ground that "the specification, while being enabling for polypeptides comprising the entire amino acid sequence of SEQ ID NO:2 and residues 16-219 of SEQ ID NO:2, does not reasonably provide enablement for isolated polypeptides comprising residues 16-37, 38-126 , 127-219 of SEQ ID NO:2." This rejection is respectfully traversed.

Contrary to the Examiner's position, the specification does provide enablement

for isolated polypeptides comprising residues 16-37, 38-126 and 127-219 of SEQ ID NO: 2. In particular, the specification clearly indicates the sequences of these specific polypeptide sequences and other information such that one of ordinary skill in the art could make and utilize the claimed polypeptides without undue experimentation. Furthermore, there is no evidence to support the Examiner's position that "a polypeptide for example, 5000 amino acids in length which merely comprises 21, 88 or 92 amino acids of SEQ ID NO:2 is not capable of retaining function of zsig63 polypeptides of this invention." Indeed, it is likely that a polypeptide containing such sequences plus additional amino acids at the C terminus and/or N terminus will retain biological activity. Therefore, the rejection is improper.

However, in order to expedite prosecution toward allowance, simplify the issues and pursue certain embodiments of the invention for business purposes, the claims have been amended in a manner believed to overcome this rejection. Applicants specifically reserve the right to pursue the subject matter canceled from the claims in a continuing application.

In view of the above, the foregoing rejection under 35 U.S.C. § 112 should be withdrawn.

(2) Rejection of Claims 11 and 20 under 35 U.S.C. § 112, first paragraph (written description)

Claims 11 and 20 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement on the ground that "[t]he polypeptides of claim 9 (see parts a-c) and its dependent claim 20 are directed to **genera** of polypeptides which have not been adequately described in the specification." This rejection is respectfully traversed.

Contrary to the Examiner's position, the specification does provide an adequate written description for isolated polypeptides comprising residues 16-37, 38-126 and 127-219 of SEQ ID NO: 2. In particular, the polypeptide fragments set forth in the instant claims are specifically described *verbatim* in the specification. Furthermore, there is no evidence to support the Examiner's statement that "Applicant is well aware that a polypeptide of for example 5000 amino acids in length which merely comprises 21 residues of SEQ ID NO:2 is not able to retain antimicrobial activities of zsig63 polypeptides." Indeed, it is likely that a polypeptide containing

such sequences plus additional amino acids at the C terminus and/or N terminus will retain biological activity. As such, there is an adequate written description of the claimed invention that clearly meets the requirements of 35 U.S.C. § 112, first paragraph. Therefore, the rejection is improper.

However, in order to expedite prosecution toward allowance, simplify the issues and pursue certain embodiments of the invention for business purposes, the claims have been amended in a manner believed to overcome this rejection. Applicants specifically reserve the right to pursue the subject matter canceled from the claims in a continuing application.

In view of the above, the foregoing rejection under 35 U.S.C. § 112 for failing to comply with the written description requirement should be withdrawn.

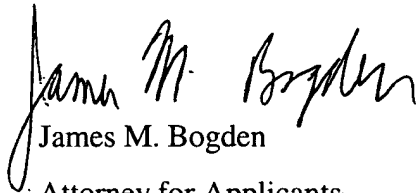
(3) Rejection of Claims 11 and 20 under 35 U.S.C. § 102(a)

Claims 11 and 20 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Jacobs (WO 99/101466, 1/14/1999). The claims have been amended in a manner believed to overcome this rejection. Therefore, the rejection should be withdrawn.

Early reconsideration and allowance of the pending claims, including the newly added claims, is respectfully requested. If the Examiner believes that a telephone interview would expedite prosecution of this patent application, please call the undersigned at (206) 442-6568.

Respectfully Submitted,

David A. Adler, Paul O. Sheppard

A handwritten signature in black ink, appearing to read "James M. Bogden". The signature is fluid and cursive, with the first name "James" and last name "Bogden" clearly legible.

James M. Bogden

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Enclosures:

Form 1449

Information Disclosure Statement

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